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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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Fort Collins, CO 80527-2400

EXAMINER

HAILE, FEBEN

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,651

Applicant(s)

CHEUNG ET AL.

Examiner

Feben M. Haile

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on October 31, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and; *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-16, and 18-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 10-16, and 18-20 of Published Application No. 2003/0088693, hereinafter referred to as Cheung et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Regarding claim 1, Cheung et al. discloses a method comprising receiving an email message at a first server, executing software on said first server to autonomously determine characteristic information of a user having submitted information included in said email message; executing software on said first server to autonomously select **(determine)** an appropriate one of a plurality of **(geographically)** distributed email servers for receipt of said email message based at least in part on said determined

(appropriate one having a characteristic associated therewith that corresponds to the determined) characteristic information of said user, and executing software on said first server to autonomously route said email message to the selected **(determined appropriate one of said plurality of geographically distributed)** email servers **(claim 1)** for handling of said email message **(claim 19)** by personnel assigned thereto **(claim 1 preamble)**.

Regarding claim 2, Cheung et al. discloses wherein said first server is a web server **(claim 1)**.

Regarding claim 3, Cheung et al. discloses wherein said first server is an email server **(claim 3)**.

Regarding claim 4, Cheung et al. discloses wherein said first server is a default email server to which email messages are sent from a web server **(claim 4)**.

Regarding claim 5, Cheung et al. discloses said user submitting information to a web server, and said web server creating an email message to communicate the submitted information to said first server **(claim 5)**.

Regarding claim 6, Cheung et al. discloses wherein said characteristic information of said user includes identification of at least one language of said user **(claim 6)**.

Regarding claim 7, Cheung et al. discloses wherein said characteristic associated with the selected **(determined appropriate one of said plurality of geographically distributed)** email servers includes identification of the geographical location of the selected email server **(determined appropriate one)** as a geographical

location in which the language common therein corresponds to the determined at least one language of said user **(claim 10)**.

Regarding claim 8, Cheung et al. discloses wherein said characteristic associated with the selected **(determined appropriate one of said plurality of geographically distributed)** email servers includes the selected email server having **(said)** personnel assigned thereto that are **(to the determined appropriate one)** capable of communicating in a language common to said at least one language of said user **(claim 11)**.

Regarding claim 9, Cheung et al. discloses wherein said characteristic information of said user includes identification of geographical location of said user **(claim 7)**.

Regarding claim 10, Cheung et al. discloses wherein said characteristic associated with the selected **(determined appropriate one of said plurality of geographically distributed)** email servers includes identification of the geographical location of the selected **(determined appropriate one)** email server as a geographical location that corresponds to the determined geographical location of said user **(claim 12)**.

Regarding claim 11, Cheung et al. discloses wherein said identification of geographical location of said user identifies a country **(claim 8)**.

Regarding claim 12, Cheung et al. discloses the limitations of base claim 1.

Cheung et al. further teaches wherein said identification of a geographical location of said user identifies a country **(claim 11)**.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that the identification of a users country would be their residence.

Regarding claim 13, Cheung et al. discloses wherein said characteristic information of said user includes information available from a database **(claim 13)**.

Regarding claim 14, Cheung et al. discloses wherein said characteristic information of said user includes information conveyed to a web server from said user **(claim 14)**.

Regarding claim 15, Cheung et al. discloses a system comprising communicative coupling to a communication network over which email messages are received, memory storing computer executable software code, processor for executing said software code to autonomously determine characteristic information of a user having submitted information included in said **(an appropriate one of a plurality of geographically distributed email server's for handling an)** email message received via said communicative coupling **(claim 15)**, and to autonomously route said email message to the determined appropriate one of said plurality of geographically distributed email servers **(claim 1)**; wherein said processor executes said software code to autonomously determine characteristic information of a user having submitted information included in said email message **(claim 15)**, said processor executes said software code to autonomously select **(determine)** an appropriate one of a plurality of geographically distributed email servers for receipt of said email message based at least in part on the **(said appropriate one having a characteristic associated therewith that corresponds to the)** determined characteristic information of said user,

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and said processor executes said software code to autonomously route said email message to the selected **(determined appropriate one of said plurality of geographically distributed)** email servers **(claim 15)** for handling of said email message by personnel assigned thereto **(claim 15 preamble)**.

Regarding claim 16, Cheung et al. discloses wherein said communication network is selected from the group consisting of: the Internet, an Intranet, an Extranet, a local area network (LAN), a wide area network (WAN), public switched telephone network (PSTN), wireless network, modem to modem connection, and any combination thereof **(claim 16)**.

Regarding claim 18, Cheung et al. discloses wherein said characteristic information of said user includes information identifying at least one language in which said user can communicate, and wherein said characteristic associated with the selected **(appropriate)** email server includes information identifying that the selected **(appropriate)** email server is located in a geographic location in which at least one of said at least one language in which said user can communicate is common to said geographic location **(claim 18)**.

Regarding claim 19, Cheung et al. discloses a system comprising plurality of **(geographically)** distributed email servers of an entity communicatively coupled to a communication network, web server communicatively accessible by at least one processor-based device, said web server executing software thereon to present an interface for said entity to a user accessing said web server via said at least one processor-based device, wherein said interface enables said user to interact therewith

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to convey information to said entity (**web server**), and at least one of (**either**) said web server and (**or one of**) said plurality of geographically distributed email servers executing software to autonomously route information conveyed to said entity (**web server**) from said user as an email message to a selected one of said plurality of (**geographically**) distributed email servers determined to be appropriate for handling of (**such**) email message (**claim 19**) by personnel assigned to the determined appropriate one (**claim 1 or 15 preamble**).

Regarding claim 20, Cheung et al. discloses wherein at least one of said (**either**) said web server and (**or one of**) said plurality of distributed email servers is operable to autonomously select said selected one of said plurality of distributed (**determine the appropriate**) email servers based at least in part on a (**identified**) characteristic associated with said selected (**appropriate**) email server corresponding to a characteristic identified for said user (**claim 20**).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. Claim 17 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of Published Application No. 2003/0088693, hereinafter referred to as Cheung et al. in view of Miyazawa et al. (US 2001/0003189), hereinafter referred to as Miyazawa.

Regarding claim 17, Cheung et al. discloses the limitations of base claim 15.

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Cheung et al. fails to teach wherein said memory comprises one or more selected from the group consisting of disk drive, floppy disk, optical disk, Compact disc (CD), Digital Versatile Disc (DVD), and random access memory (RAM).

Miyazawa discloses a medium recording a program for a computer to execute the data transmission method for a client server system which is comprised of a server and a plurality of clients connected to the sever via communication lines (**page 2 paragraph 0015**), where the medium includes a floppy disk, a hard disk, a magneto-optical disk, CD-ROM, a DVD, and a RAM memory (**page 2 paragraph 0017**).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cheung et al. to incorporate the medium taught by Miyazawa. The motivation being a graphical user interface with superb operability for exchanging messages.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miloslavsky (US 6,732,156) in view of Tarbotton et al. (US 6,757,830), hereinafter referred to as Tarbotton.

Regarding claims 1, 15 and 19, Miloslavsky discloses receiving an email message at a first server (**Figure 3 step 152 and column 5 lines 34-35; e-mail server receives email**); executing software on said first server to autonomously determine characteristic information of a user having submitted information included in said email message (**Figure 3 step 154 and column 5 lines 36-37; information is extracted from the e-mail**); executing software on said first server to autonomously select an appropriate one of a plurality of distributed e-mail servers for receipt of said email message based at least in part on said determined characteristic information of said user (**Figure 3 step 158 and column 5 lines 42-44; using information to make routing decision**), and executing software on said first server to autonomously route said email message to the selected email server (**Figure 3 step 160 and column 5 lines 44-46, e-mail is routed to the selected person**).

Miloslavsky only show one recipient mail server (**102 of Figure 1**). That is because all the supported persons in Miloslavsky are located in one processing center (**Figure 1 unit 100 column 5 lines 21-23**).

Tarbotton shows in **Figure 1** that all e-mail recipients require a recipient mail server in order to receive e-mails from Internet or network.

It would have been obvious to one having ordinary skill in the art at the time the invention was made incorporate more e-mail servers as taught by Tarbotton. The motivation being so that all of the support persons will be able to receive e-mails.

Regarding claim 2, Miloslavsky discloses wherein said first server is a web server (**Figure 1 unit 102 and 104; it is obvious to one having ordinary skill in the**

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art that the email server 102 could also be a web server because it is attached to data network 104, which can be the Internet).

Regarding claim 3, Miloslavsky discloses wherein said first server is an email server **(Figure 1 unit 102; e-mail server).**

Regarding claim 4, Miloslavsky discloses wherein said first server is a default email server to which email messages are sent from a web server **(Figure 1 unit 106, 104 and 102; computer 106, which can be a web server because it is attached to data network 104, which can be the Internet sends an email message to email server 102).**

Regarding claim 5, Miloslavsky discloses said user submitting information to a web server **(column 5 lines 23-25; support person logs onto a stat-server);** and said web server creating an email message to communicate the submitted information to said first server **(column 5 lines 27-28; router sends command to email server to route e-mail to selected terminal, which the support person responds to).**

Regarding claim 6, Miloslavsky discloses wherein said characteristic information of said user includes identification of at least one language of said user **(column 3 lines 53-64; emails are routed to support persons depending on its various information such as language ability).**

Regarding claim 7, Miloslavsky discloses wherein said characteristic associated with the determined appropriate one of said plurality of geographically distributed email servers includes identification of the geographical location of the determined appropriate one as a geographical location in which the language common therein corresponds to

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the determined at least one language of said user (**column 3 lines 53-64; emails are routed to support persons depending on its various information such as language ability**).

Regarding claim 8, Miloslavsky discloses wherein said characteristic associated with the determined appropriate one of said plurality of geographically distributed email servers includes said personnel assigned to the determined appropriate one capable of communicating in a language common to said at least one language of said user (**column 3 lines 53-64; emails are routed to support persons depending on its various information such as language ability**).

Regarding claim 13, Miloslavsky discloses wherein said characteristic information of said user includes information available from a database.

Regarding claim 14, Miloslavsky discloses wherein said characteristic information of said user includes information conveyed to a web server from said user.

Regarding claim 16, Miloslavsky discloses wherein said communication network is selected from the group consisting of: the Internet, an Intranet, an Extranet, a local near area network (LAN), a wide area network (WAN), public switched telephone network (PSTN), wireless network, modem to modem connection, and any combination thereof (**Figure 1 unit 104 column 3 lines 4-6; data network could be a LAN, or WAN, or Internet, or Intranet**).

Regarding claim 20, Miloslavsky discloses wherein either said web server or one of said plurality of distributed email servers is operable to autonomously determine the appropriate email server based at least in part on an identified characteristic

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associated with said appropriate email server corresponding to a characteristic identified for said user (**column 3 lines 53-64; emails are routed to support persons depending on its various information**).

4. Claims 9-12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miloslavsky (US 6,732,156) in view of Tarbotton et al. (US 6,757,830), hereinafter referred to as Tarbotton in view of Zoken (US 5,944,787).

Regarding claim 9, Miloslavsky as combined with Tarbotton disclose the limitations of base claim 1.

Miloslavsky as combined with Tarbotton fail to teach wherein said characteristic information of said user includes identification of a geographical location of said user.

Zoken discloses receiving a message comprising an email address (**Figure 1 unit 12 column 2 lines 51-54**) and processing the message to detect the geographic locale of the sender (**Figure 1 unit 17 column 3 lines 32-36**).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Miloslavsky and Tarbotton to incorporate the method taught by Zoken. The motivation being an automated mechanism for mapping a users email address to and from the users corresponding postal address.

Regarding claim 10, Miloslavsky as combined with Tarbotton disclose the limitations of base claim 1.

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Miloslavsky as combined with Tarbotton fail to teach wherein said characteristic associated with the determined appropriate one of said plurality of geographically distributed email servers includes identification of the geographical location of the determined appropriate one as a geographical location that corresponds to the determined geographical location of said user.

Zoken discloses receiving a message comprising an email address (**Figure 1 unit 12 column 2 lines 51-54**) and processing the message to detect the geographic locale of the sender (**Figure 1 unit 17 column 3 lines 32-36**).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Miloslavsky and Tarbotton to incorporate the method taught by Zoken. The motivation being an automated mechanism for mapping a users email address to and from the users corresponding postal address.

Regarding claim 11, Miloslavsky as combined with Tarbotton disclose the limitations of base claim 1.

Miloslavsky as combined with Tarbotton fail to teach wherein said identification of a geographical location of said user identifies a country.

Zoken discloses receiving a message comprising an email address (**Figure 1 unit 12 column 2 lines 51-54**) and processing the message to detect the geographic locale of the sender (**Figure 1 unit 17 column 3 lines 32-36**).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Miloslavsky and Tarbotton to

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incorporate the method taught by Zoken. The motivation being an automated mechanism for mapping a users email address to and from the users corresponding postal address.

Regarding claim 12, Miloslavsky as combined with Tarbotton disclose the limitations of base claim 1.

Miloslavsky as combined with Tarbotton fail to teach wherein said characteristic information of said user includes identification of a geographical location of said user's residence.

Zoken discloses receiving a message comprising an email address (**Figure 1 unit 12 column 2 lines 51-54**) and processing the message to detect the geographic locale of the sender (**Figure 1 unit 17 column 3 lines 32-36**).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Miloslavsky and Tarbotton to incorporate the method taught by Zoken. The motivation being an automated mechanism for mapping a users email address to and from the users corresponding postal address.

Regarding claim 18, Miloslavsky as combined with Tarbotton disclose the limitations of base claim 15. Miloslavsky as combined with Tarbotton further disclose wherein said characteristic information of said user includes information identifying at least one language in which said user can communicate (**column 3 lines 53-64; emails are routed to support persons depending on its various information such as language ability**).

Zoken discloses receiving a message comprising an email address (**Figure 1 unit 12 column 2 lines 51-54**) and processing the message to detect the geographic locale of the sender (**Figure 1 unit 17 column 3 lines 32-36**).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Miloslavsky and Tarbotton to incorporate the method taught by Zoken so wherein said characteristic associated with the appropriate email server includes information identifying that the appropriate email server is located in a geographic location in which at least one of said at least one language in which said user can communicate is common to said geographic location. The motivation being an automatic mechanism for routing emails to users depending on language ability and mapping the users email address to and from the users corresponding postal address.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miloslavsky (US 6,732,156) in view of Tarbotton et al. (US 6,757,830), hereinafter referred to as Tarbotton in view of Miyazawa et al. (US 2001/0003189), hereinafter referred to as Miyazawa.

Regarding claim 17, Miloslavsky as combined with Tarbotton disclose the limitations of base claim 15. Miloslavsky further discloses a storage device for storing an algorithm (**column 4 lines 37**).

Miloslavsky fails to teach wherein said memory comprises one or more selected from the group consisting of: disk drive, floppy disk, optical disk, Compact Disc (CD), Digital Versatile Disc (DVD), and random access memory (RAM).

Miyazawa discloses a medium recording a program for a computer to execute the data transmission method for a client server system which is comprised of a server and a plurality of clients connected to the sever via communication lines (**page 2 paragraph 0015**), where the medium includes a floppy disk, a hard disk, a magneto-optical disk, CD-ROM, a DVD, and a RAM memory (**page 2 paragraph 0017**).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate into the combination of Miloslavsky and Tarbotton the medium taught by Miyazawa. The motivation being a graphical user interface with superb operability for exchanging messages.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Nolan et al. (US2002/0091776), Email Processing

b) Degolia (US 6,512,763), Method and Apparatus for Data Routing, Delivery, and Authentication in a Packet Data Network


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Feben M. Haile whose telephone number is (571) 272-3072. The examiner can normally be reached on 6:00am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on (571) 272-3139. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH 07/22/2005


RICKY NGO
PRIMARY EXAMINER

4/15/05